

Application No. 10/727,246

April 20, 2005

Amendment responsive to Office Action of December 10, 2005

**Remarks**

The drawings stand objected to under 37 CFR 1.83(a) because the drawings must show every feature of the invention specified by the claims. Applicants have added Figure 9. Fig. 9 illustrates a system with a motor, a gear, and two gear tooth sensors. Under 37 CFR 1.83(a), a simple block diagram is sufficient because motors and gears are well known and because the placement of a gear tooth sensor in proximity to a gear is disclosed in the specification and in Figs. 2-4. No new material is introduced because, as per Examiner's objection, the matter was disclosed in the claims but not illustrated in Figs. 1-8.

Pending claims 7, 9, and 12 stand objected to by the examiner due to informalities. Applicants have amended claims 7 and 9 in accordance with Examiners remarks. Applicants have not amended claim 12 because the word "comprises" truly indicates Applicants intent whereas the word "is" does not. The gear tooth sensor can comprise a magnet as seen in Fig. 2 that shows a magnet as element 20. The magnet 20 can be used to dispose the first magnetically sensitive device 12 and the second magnetically sensitive device 14 in a magnetic field. If the sensor "is" a magnet, as Examiner suggests, then there would be no sensing at all because the magnet, by itself, is not sensing gear tooth position. A sensor comprising a magnet as well as other sensing elements, such as Hall sensors, can detect gear tooth position.

Pending claims 1-21 stand rejected by the examiner under 35 U.S.C. 112 first paragraph under the theory that calibration of the latch assembly is not in the specification in such a manner that one skilled in the art could make or use the invention. Applicants have amended claims 1 and 11 in response to Examiner's rejection. Please note, however, that Examiner supplied the material to overcome Examiner's own rejection. Examiner also rejected many claims as anticipated by US Patent 5,765,884 granted to Armbruster. Armbruster applied

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for the referenced patent in 1996 and it was granted in 1998. Armbruster (column 1 line 63 to column 2 line 1) discusses a calibration example as prior art. This shows that at least one calibration issue and example related to motorized latches was considered well known in the field by at least one person skilled in the art 7 years prior to the filing of the present application and was published 5 years prior to the filing of the present application. Armbruster has been freely available over the internet for much of that time. One skilled in the art should be assumed to be unaware of half decade old publications in his own field. Furthermore, Armbruster is now part of the prosecution history of the present application resulting in an even greater degree of enablement.

Pending claims 3 stands rejected by the examiner under 35 U.S.C. 112 second paragraph. Applicants have amended claim 3 in response to Examiner's rejection.

For the foregoing reasons, rejection of claims 1, 3 and 11 under 35 USC 112 as amended is respectfully traversed. Furthermore, successfully traversing the rejection of claims 1 and 11 results in traversing the rejection to claims 2-10 and 12-21. As such, Examiner is requested to reconsider the claims.

Pending claims 1, 3 – 7, 10, 11, 13 – 17, 20 and 21 stand rejected by the Examiner under 35 U.S.C. §102(b) as anticipated by Armbruster. Pending claims 8, 9, 18, and 19 stand rejected by the Examiner under 35 U.S.C. §103(a) as obvious in view of Armbruster. Pending claims 2 and 12 stand rejected by the Examiner under 35 U.S.C. §103(a) as obvious in view of Armbruster in combination with US Patent 5,304,926 issued to Wu.

**Requirements for *Prima Facie* Anticipation**

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A general definition of *prima facie* unpatentability is provided at 37 C.F.R. §1.56(b)(2)(ii):

A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, Armbruster must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i. e.*, show that Armbruster fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a *prima facie* case of unpatentability, then without more the applicants are entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

### **Application of Anticipation Requirements**

With respect to the rejection of the claims, the Examiner cites Fig. 1 of

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Armbruster claiming it teaches "a gear tooth sensor (37) that senses a position of at least one gear to thereby provide a reference point registration and calibration via the collected data (Col. 5 Line 27 to Col. 6 Line 5)." Further consideration of the reference will reveal that Armbruster actually teaches something else. First, element 37 is not a gear tooth sensor but is a hall-effect sensor used to sense a magnet connected to a motor shaft. The sensor and associated circuitry are designed to count revolutions of the motor shaft. The associated circuitry must infer gear tooth position from the number of motor revolutions, and the gear ratios. Armbruster's apparatus can not detect errors resulting from gear slippage. Applicants teach the use of a gear tooth sensor in a latch mechanism where the gear tooth sensor can detect the movement of gear teeth themselves. This is superior to Armbruster because the gear teeth themselves are sensed instead of a spinning shaft at the far end of a gear train. Furthermore, Applicants teach using a sensor that detects movement of the gear itself while Armbruster teaches sensing an element attached to a shaft. Applicants do not require attaching extra things to the gear or drive train. The superiority of Applicants' system and method has nothing to do with "discovering an optimum value of a result effective variable" as Examiner asserts. The superiority has to do with properly using a superior sensor in a superior position to accomplish a task.

For the foregoing reasons, rejection of claims 1, 3 – 7, 10, 11, 13 – 17, 20 and 21 under 35 U.S.C. §102(b) is respectfully traversed and examiner is requested to reconsider them.

#### **Requirements for *Prima Facie* Obviousness**

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

The examiner bears the initial burden of factually supporting any *prima facie*

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conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

M.P.E.P. §2143 sets out the three basic criteria that a patent examiner must satisfy to establish a *prima facie* case of obviousness:

1. some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2. a reasonable expectation of success; and
3. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the examiner (assuming there are no objections or other grounds for rejection), an applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443 (Fed. Cir. 1992).

Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that each of the three aforementioned basic criteria has been met.

### **Application of Obviousness Requirements**

The applicants respectfully assert that the rejection of claims 2 and 12 herein fails under the third prong of the obviousness test because Wu never suggests a door latch and Armbruster, as discussed earlier, teaches a motor shaft sensor completely unlike and inferior to the gear tooth sensor taught by Wu. Applicants separately contend that the rejection fails to satisfy the first because, in view of the objectives and teachings of the references, there is no motivation or suggestion to combine them. In this regard, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must

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both be found in the prior art, not in the applicants' disclosure.

It is thus improper for the Examiner to formulate the suggestion or motivation to combine prior art references based on current knowledge. As stated by the Federal Circuit Court in the opinion of *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988):

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board.

Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'

The foregoing comprises a caution against piecing together disparate and unrelated disclosures found in the prior art to meet a claimed structure, in the absence of any suggestion in the references implying the desirability of doing so. The applicants respectfully assert that, in view of the aforementioned guideline, combining *Lagouarde* and *Gaul* is improper and, therefore, a *prima facie* case of obviousness against claim 21 cannot be established.

The applicants also respectfully assert that the rejection of claims 8, 9, 18 and 19 fails under the first and third prong of the obviousness test because, as discussed above, Armbruster never teaches use of a gear tooth sensor as taught by applicants. There can be no suggestion or motivation to use a plurality of an element when that element is never even taught.

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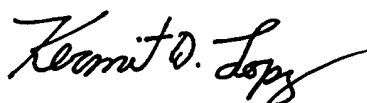
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### **Conclusion**

In view of the foregoing remarks, the Applicants submit that claims 1-20 as amended are patentably distinct over the references and are in allowable form. Accordingly, the Applicants earnestly solicit the favorable consideration of their application, and respectfully requests that it be passed to issue in its present condition.

Should the Examiner discern any remaining impediment to the prompt allowance of the aforementioned claims that might be resolved or overcome with the aid a telephone conference, he is cordially invited to call the undersigned at the telephone number set out below.

Respectfully submitted,

A handwritten signature in black ink, reading "Kermit D. Lopez". The signature is fluid and cursive, with the first letters of each word being capitalized and prominent.

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